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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,694	11/25/2003	William T. Ball	5564-138B	6303
23442	7590	03/13/2009		
SHERIDAN ROSS PC 1560 BROADWAY SUITE 1200 DENVER, CO 80202			EXAMINER FETSUGA, ROBERT M	
			ART UNIT	PAPER NUMBER
			3751	
			MAIL DATE	DELIVERY MODE
			03/13/2009 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/721,694

**Applicant(s)**

BALL, WILLIAM T.

**Examiner**

Robert M. Metsuga

**Art Unit**

3751

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5,8 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5,8 and 25-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 21, 2009 has been entered. Accordingly, claims 5, 8 and 25-29 are pending as indicated at page 4 of the submission. Re claim 5, the examiner is unaware of any provision which permits a pending claim, not subject to restriction requirement, to be identified as "Withdrawn".

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Proper antecedent basis for the "interconnected" feature set forth in claims 5, 25 and 27, the subject matter set forth on the last two lines of claim 25, and the threads on "an inner diameter" set forth in claims 26 and 28, could not be found in the specification. Applicant is reminded claim terminology in mechanical cases should appear in the descriptive portion of the specification by reference to the drawing(s).

Applicant argues at page 8 of the response filed January 21, 2009 the language of claim 25 defining the membrane positioning was supplied by the amendment filed July 26, 2007. However, the examiner has again reviewed the noted amendment, but did not find the language of claim 25 therein.

3. Claims 5, 8 and 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is unclear as to the relationship between the "interior threads" on line 4, and the "interconnected" feature on line 3 thereof. The claim is unclear as to the relationship between the "threadingly engages" feature on line 9, and the "interior threads" on line 4 thereof. Claims 25 and 27 are similarly indefinite.

Claim 25 lacks sufficient antecedent basis for the "thin membrane" on line 8. Claim 8 is similarly indefinite.

Claim 26 is unclear as to the relationship between the "threads" on lines 1-2 thereof, and the "threadingly engages" feature on line 7 of claim 25. Claim 28 is similarly indefinite.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 5, as best understood, is rejected under 35 U.S.C. 102(a/e) as being anticipated by Minnick.

The Minnick reference discloses an overflow system comprising: a pipe 3; a cap 5 including a cylindrical body 6 having an outer face 11, interior threads 9 (col. 3 lns. 20-22),

an annular flange 11, and an open end 14; and a membrane 16,17, as claimed. The membrane is "affixed to said face and said flange" since the claimed face (54) is part of the flange (64), as stated in the response filed January 03, 2008 at pages 11-12, and the membrane 16,17 of Minnick is affixed to the face 11 via rim 18 (col. 3 lns. 51-57).

6. Claims 5, 8 and 25, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Rabinovich.

The Rabinovich reference discloses a system comprising: a pipe 77; a cap 82 including a cylindrical body (col. 4 lns. 23-25) having an outer face (surface of 85 facing outward), interior threads 84, an annular flange (defining 85), and an open end (through which 77 extends); and a membrane 87, as claimed. The initial statement of intended use (overflow, bathtub), and all other functional implications (cl. 8), have been considered but do not appear to impose any patentably distinguishing structure over that disclosed by Rabinovich. The pipe 77 is threaded (84), and the cap threadingly engages the pipe as depicted in Fig. 3. Re claim 25, the (thin) membrane "is positioned substantially entirely on said face and has an outer surface coincident with an outer surface of said flange" as depicted in Fig. 2 of Rabinovich.

Applicant argues at page 10 of the response filed January 21, 2009 Rabinovich does not disclose the language of claim 25 defining the membrane positioning. The examiner disagrees. The broad and ambiguous claim language does not distinguish the structure disclosed by Rabinovich.

7. Claim 5, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Minnick.

In addition to the embodiment discussed supra, another embodiment of an overflow cap 50 is disclosed in Figs. 10-12 of Minnick. The cap 50 includes a membrane 54 affixed directly to a flange/face 52,55. The flange/face 52,55 is analogous to the previously noted flange/face 11. While Minnick does not explicitly state that the associated threads (of 51) can be constructed internally of the cap 50, it would have been obvious to provide such in light of the alternative construction taught by Minnick at column 3, lines 20-22.

8. Claims 5, 8 and 25-29, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ball and Minnick.

The Ball reference discloses an overflow system comprising: a pipe 34; a cap including a cylindrical (Fig. 6) body 60 having an outer face 62, an annular flange 70 extending both inwardly and outwardly therefrom, and an open end 54; and a membrane 64.

The (thin) membrane "is positioned substantially entirely on said face and has an outer surface coincident with an outer surface of said flange" as depicted in Figs. 3 and 4 of Ball. Therefore, Ball teaches all claimed elements except for the provision of threads.

Although the cap of the Ball overflow system does not include threads, as claimed, attention is directed to the Minnick reference which discloses an analogous overflow system which further includes a cap 5 having threads 9. Therefore, in consideration of Minnick, it would have been obvious to one of ordinary skill in the overflow system art to associate threads with the Ball cap in order to facilitate installation (col. 1 lns. 43-47). Furthermore, Minnick teaches the obvious alternative of reversing the illustrated threading scheme (col. 3 lns. 20-22). Re claim 26, to associate threads on both the outside and inside of the pipe would have been obvious in order to enable a single pipe to be used with two different forms of a cap.

9. Applicant's arguments throughout the response directed towards subject matter previously indicated allowable by the examiner are noted. Regretfully, the previously indicated allowable matter is not now considered allowable for the reasons



advanced supra. Accordingly, this Office action is made non-final.

10. Applicant is referred to MPEP 714.02 and 608.01(o) in responding to this Office action.

11. Any inquiry concerning this communication should be directed to Robert M. Fetsuga at telephone number 571/272-4886 who can be most easily reached Monday through Thursday. The Office central fax number is 571/273-8300.

/Robert M. Fetsuga/  
Robert M. Fetsuga  
Primary Examiner  
Art Unit 3751